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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,082	08/17/2001	Yasushige Nakamura	011040	2870

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ARMSTRONG, WESTERMAN & HATTORI, LLP
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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/08/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/931,082

Applicant(s)

NAKAMURA ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): sec. 103 rej of Ishimaru in view of Yamanaka.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: 7-14.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


**CHRISTOPHER RODEE
PRIMARY EXAMINER**

Continuation of 2. NOTE: The proposed amendment to claim 6 raises the issue of new matter because there does not appear to be basis in the specification for "an electrographic toner". "Electrophotographic" copy systems are disclosed but there does not appear to be basis for the claim as presented. Further, it is unclear how this phrase (or the phrase "an electrophotographic toner") would further limit the color imaging toner of claim 1 because the disclosure indicates that the color imaging toner is only for electrophotographic systems (e.g., spec. p. 1). It appears that the toner as presented already has function as proposed. Clarification is requested if applicants further request entry of either "electrographic" or "electrophotographic" toner as it is unclear how these terms further limit claim 1 (see 37 CFR 1.75c).

Continuation of 5. does NOT place the application in condition for allowance because: Kushino specifically calls for colorless charge control agents (col. 20, l. 19-20; see applicants remarks p. 5, l. 11-12). The proposed combination is not an "obvious to try" standard because there is clear suggestion of using a colorless charge control agent to Kushino's toner and Yamanaka discloses such a toner. There is a reasonable expectation of success in combining the references because both references are directed to the same art area and produce toner compositions having similar components (e.g., binder resin, colorant, charge control agent, etc.). The proposed combination does not need to recognize the same benefits as applicants in order to make a proper section 103 rejection. The rejection is proper and is maintained.